

Rejections Under 35 U.S.C. § 112, 1st Paragraph:

Claims 1-29 were rejected under 35 U.S.C. § 112, 1st Paragraph, as containing subject matter which was not described in the specifications in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The Examiner stated that claims limited to SEQ ID NOs 1-3 were fully enabled. However, the Examiner stated that "[c]loning the large number of constructs and making the transgenic plants comprising those constructs to find another Lucerne promoter, or a fragment of a lucerne PR promoter having activity in plants, or a polynucleotide sequence having at least 80%, 90%, or 95% sequence identity to a promoter of lycerne PR protein, and still able to function as an inducible lucerne promoter would require undue trial and error experimentation to make and use the invention." (Page 6, last line - page 7, end first paragraph).

The applicants respectfully traverse.

The techniques required to transfect heterologous DNA into plant cells, and to screen the transfected cells for the presence of the trait conferred by such DNA is suitably performed by undergraduate biology students. Transmitted herewith, in the accompanying IDS is such a protocol (*Hosts For Gene Cloning In Plants*) for use by undergraduates of the University of Sussex. The required experiments are simply and rapidly performed. Moreover, the experiments do not require the growing of large numbers of plants. Rather, the experiments are performed using protoplasts, which are isolated plant cells lacking cell walls. Thousands of constructs may be rapidly, cheaply, and simply screened by commercially-available protocols. (See Luehrsen and Walbot, *Firefly Luciferase As A Reporter For Plant Gene Expression Studies*, 1993 attached IDS).

Persons of skill in the molecular biological arts, at the time of invention, would have been able to perform the present invention without undue experimentation. Therefore, in view of the state of the art, once given the teachings of the present invention, persons of skill would have been fully enabled to practice the claims of the present invention. Moreover, the claims were fully enabled at the time of submission of the original application.

Conclusion:

In view of the above, consideration and allowance are, therefore, respectfully solicited.

Accordingly, it is respectfully requested that the foregoing amendments be entered, that the application as so amended receive an examination on the merits, and that the claims as now presented receive an early allowance.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication, including any extension fees or fees for the net addition of claims, to Deposit Account No. 22-0185.

Respectfully submitted,



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